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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/415,632	10/12/1999	Suzanne P. Crane	10655.7700	5093
7590 Howard I Sobelman Snell & Wilmer LLP One Arizona Center 400 East Van Buren Phoenix, AZ 85004-2202		06/20/2007	EXAMINER POINVIL, FRANTZY	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 06/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/415,632

Applicant(s)

CRANE ET AL.

Examiner

Frantzy Poinvil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/20/2007 have been fully considered but they are not persuasive.

Applicant's representative argues that Fernandez is limited to a system monetary Amounts are contributed by a non-cardholder (i.e., credit card issuer)" which "requires the credit card issuer to outlay a large amount of its own credit card issuers funds to reward the cardholder by depositing the credit card issuer funds into the cardholder investment account. Applicant's representative then states that the Examiner does not disclose or suggest any of the following features of:

combined remittances by the user of user funds, wherein the user submits a finance card payment and investment funds together to the finance card issuer;
payment hierarchy and investment hierarchy for distributing the combined remittance of user funds to financial events and investment brokerage;
user investment instruction information; and
payment hierarchy; distributing user funds to an investment product;

In response, the provision of these features or limitations were noted to be taught by the combination of not only Fernandez but by combined teachings of Fernandez-Homann in view of Lupien et al or Wallman (US Patent No. 6,601,044).

Furthermore, it is noted that Fernandez does teach a financial events database, an investment system and a remittance database. Fernandez does not explicitly state a payment hierarchy system and investment hierarchy for distributing a combined remittance of user funds to related financial events and an investment system as

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claimed. It is noticed that in the system of Fernandez, financial transactions are performed by a user and funds are deposited into the investment account by the user. Funds are deposited into the investment account by the user and by the credit card issuer when the user has failed to make a payment. However, it should be noted that the user is being charged when funds are deposited to the user's investor account by the card issuer as such is both beneficial to the card issuer because a fee and an interest are being charged to the user's credit card account and also because investment funds are always deposited to the user's investment accounts so as to prevent the user or investor from making untimely investment disbursements thereby providing the user the advantage of other late payment charges at the same time enabling the user to profit in the investment strategy system.

As per the arguments concerning that the card issuer is rewarding the card user, it is noted that the applicant is speculating and merely arguing "things" or "acts" that are not present in the claims or being performed by Fernandez. The credit card issuers do not reward clients or credit card holders who do not make their monthly payments as stated by the applicant. The credit card issuer instead deposits funds into the investment account of the cardholder and charges the card holder the deposited amount and also an additional fee for depositing funds into the user's investment account.

Applicant's representative then states that in the system of Fernandez there include many disadvantages because the card issuer must allocate a large sum of funds for future allocation to the cardholder's investment account.

In response, the Examiner disagrees because while it may be true that Fernandez allocates a large sum of money for future allocation to the cardholder's account, it should be noted that this fund is considered as a loan against the cardholders card account which functions in a similar manner when a card issuer issues credits or loans to a cardholder.

The prior Office action is repeated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Homann (US Patent No. 5,787,404) in view of Lupien et al (US Patent No. 5,101,353) or Wallman (US Patent No. 6,601,044).

As per claims 1 and 6, Fernandez-Holmann discloses a method and system for providing an investment to a cardholder by establishing a credit based account with a credit card issuer for the benefit of the credit card holder. See the abstract. The system and method comprise:

a charge card billing system configured to capture financial event information wherein the billing system comprises a card account database configured to include user accounts, a billing information database, a financial events database, a remittance database configured to include information about user remittances, wherein the combined remittance includes a portion of funds to satisfy debts related to the financial events (see figure 5 and column 2, lines 23-55).

Fernandez-Holman also discloses providing periodic statements related to previously established financial events as do most credit card issuers (see column 4, lines 4-44).

Fernandez-Holmann also teach an investment broker system for investing a cardholder's funds from either payment from the cardholder's monthly payment or funds deducted from the cardholder's credit card. The broker system is in communication with the billing system (see column 4, lines 45-66 of Fernandez-Holmann) wherein the broker system comprises:

an instruction arrangement database configured to include user investment instruction information and an account database configured to include multiple investment products (see column (column 6, lines 4-26 of Fernandez-Holmann);

Fernandez-Holmann does not explicitly teach a payment hierarchy system for establishing rules for distributing funds to the at least one product or investment account. As per this teaching in an investment system, funds allocation and rules are usually provided from the investor to a broker for investment purposes. See the teachings of Lupien et al or Wallman.

Fernandez-Holmann also teach a remittance database configured to include information about user combined remittances wherein the combined remittances include a portion of funds to

satisfy debts related to previously established financial events disclosed in a periodic statement and a portion of funds for investment. See columns 4 and 6 of Fernandez-Holmann.

Both Lupien et al and Wallman are directed to a system and method in which a central system manages investment data for an investor. See the abstract of both references.

Fernandez-Holmann teaches a remittance database configured to include information about user combined remittances wherein the combined remittances include a portion of funds to satisfy debts related to previously established financial events disclosed in a periodic statement and a portion of funds for investment. See columns 4 and 6 of Fernandez-Holmann.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Lupien et al or Wallman into Fernandez-Holmann in order to provide a cardholder with a detailed analysis of their investment or returns regarding their investment.

As per claims 2 and 7, Fernandez-Holmann discloses the investment products include at least one of a fixed annuity, variable annuity, CD, insurance, certificate, equity and mutual fund. See column 6, lines 20-25 and the teachings of Wallman or Lupien et al for these types of investment products..

As per claims 3 and 8, Fernandez-Holmann teaches the billing system is configured to avoid a collection process upon remittance of sufficient financial event funds and insufficient investment funds. See columns 4 and 6.

As per claim 4, Fernandez-Holmann teaches that the investment products are pre-selected by the cardholders as a retirement account. See the abstract of Fernandez-Holman.

As per claims 5 and 10, Fernandez-Holmann discloses the billing system and the investment broker system are configured to be accessed via at least one of a telecommunications linkage, facsimile, Internet and a point of interaction device. See columns 4-6 of Fernandez-Holmann.

As per claim 9, discloses selecting the investment products (such as an IRA or 401(k) plan) prior to the remitting step.

3. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Fernandez-Holmann and Wallman or Lupien et al.) in further view of Sandberg-Diment (US Patent No. 5,826,245).

The teachings of Fernandez-Holmann, Lupien et al. and Wallman are discussed above. Steps of authorizing the account number and purchase amount, providing an approval code associated with the account number and the purchase amount to the merchant is not explicitly stated in the combination of Fernandez-Holmann and Wallman or Lupien et al. The Examiner asserts that these are well known steps taken when using a credit card to make a payment using a financial transaction card. Sandberg-Diment discloses a system and method whereby a cardholder performs a financial transaction using a financial card. An approval code is sent to a merchant who then uses the approval code when requesting a payment for the transaction for the purchase amount. Applicant is directed to column 3, lines 55-67 of Sandberg-Diment.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Sandberg-Diment into the combined system of Fernandez-

Holmann and Wallman or Lupien et al. in order to discourage fraudulent transactions, thereby providing a more secure system.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:30AM to 5:00PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fisher can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Frantzy Poinvil
Primary Examiner
Art Unit 3692

FP

May 30, 2007